



JJGJr.:03-01

Paper 5

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**MAR 12 2001**

In re Application of  
Mellmer, et al  
Application No. 09/670,783  
Filed: 27 September, 2000  
Attorney Docket No.: 1909.2.74A

**OFFICE OF PETITIONS  
A/C PATENTS  
ON PETITION**

This is in response to the petition under 37 C.F.R. §1.47,<sup>1</sup> specifically §1.47(a), filed 14 November, 2000.<sup>2</sup>


The petition is **GRANTED**.

Petitioner has shown that the non-signing inventor cannot be found or otherwise refused to join in the filing of the above-identified application.

The above-identified application and papers have been reviewed and found in compliance with 37 C.F.R. §1.47(a).

This application is hereby accorded Rule 1.47(a) status. As provided in Rule 1.47(a), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the Declaration. Notice of the filing of this application will also be published in the Official Gazette.

Telephone inquiries regarding this communication should be directed to the Petitions Attorney John J. Gillon, Jr., at (703)305-9199.

  
John J. Gillon, Jr.  
Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

<sup>1</sup> The regulations at 37 C.F.R. §1.47 provide:

**§1.47 Filing when an inventor refuses to sign or cannot be reached.**

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(i) and the last known address of the nonsigning inventor. The Patent and Trademark Office shall, except in a continued prosecution application under § 1.53(d), forward notice of the filing of the application to the nonsigning inventor at said address and publish notice of the filing of the application in the Official Gazette. The nonsigning inventor may subsequently join in the application on filing an oath or declaration complying with § 1.63.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § 1.17(i), and the last known address of all of the inventors. The Office shall, except in a continued prosecution application under § 1.53(d), forward notice of the filing of the application to all of the inventors at the addresses stated in the application and publish notice of the filing of the application in the Official Gazette. An inventor may subsequently join in the application on filing an oath or declaration complying with § 1.63.

[47 Fed. Reg. 41275, Sept. 17, 1982, effective Oct. 1, 1982; 48 Fed. Reg. 2709, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997]

<sup>2</sup> A prior petition, filed on 10 May, 1999 (and again on 24 August, 2000), was dismissed on 18 September, 2000, when Petitioner failed to submit a Declaration/Oath of the co-inventors on behalf of themselves and the missing inventor.



your position of record in the application;

- alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you.

If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 C.F.R. §1.63.<sup>4</sup>

or statutory invention registration containing color drawing:

- (i) Regular service 3.00
- (ii) Overnight delivery to PTO Box or overnight fax 6.00
- (iii) Expedited service for copy ordered by expedited mail or fax delivery service and delivered to the customer within two workdays 25.00

- (2) Printed copy of a plant patent in color 15.00
- (3) Copy of a utility patent or statutory invention registration containing color drawing (see § 1.84(a)(2)) 25.00

(b) Certified and uncertified copies of Office documents:

- (1) Certified or uncertified copy of patent application as filed:
  - (i) Regular service 15.00
  - (ii) Expedited regular service 30.00
- (2) Certified or uncertified copy of patent-related file wrapper and contents 150.00
- (3) Certified or uncertified copy of Office records, per document except as otherwise provided in this section 25.00
- (4) For assignment records, abstract of title and certification, per patent 25.00
- (c) Library service (35 U.S.C. 13): For providing to libraries copies of all patents issued annually, per annum 50.00
- (d) For list of all United States patents and statutory invention registrations in a subclass 3.00
- (e) Uncertified statement as to status of the payment of maintenance fees due on a patent or expiration of a patent 10.00
- (f) Uncertified copy of a non-United States patent document, per document 25.00
- (g) To compare and certify copies made Fed. Reg. om Patent and Trademark Office records but not prepared by the Patent and Trademark Office, per copy of document . . . 25.00
- (h) Additional filing receipts; duplicate; or corrected.

[Added 47 Fed. Reg. 41273, Sept. 17, 1982, effective date Oct. 1, 1982; para. (b), 49 Fed. Reg. 552, Jan. 4, 1984, effective date Apr. 1, 1984; paras. (f) and (g) Added, 49 Fed. Reg. 34724, Aug. 31, 1984, effective date Nov. 1, 1984; paras. (a) and (c), 50 Fed. Reg. 9379, Mar. 7, 1985, effective date May 8, 1985; 50 Fed. Reg. 31825, Aug. 6, 1985, effective date Oct. 5, 1985; revised, 54 Fed. Reg. 6893, Feb. 15, 1989; 54 Fed. Reg. 9432, March 7, 1989, effective Apr. 17, 1989, revised 56 Fed. Reg. 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (b)(4), (f) and (h), 57 Fed. Reg. 38190, Aug. 21, 1992, effective Oct. 1, 1992; para. (a)(3), 58 Fed. Reg. 38719, July 20, 1993, effective Oct. 1, 1993; paras. (a)(1)(ii), (a)(1)(iii), (b)(1)(i), & (b)(1)(ii) amended, 60 Fed. Reg. 41018, Aug. 11, 1995, effective Oct. 1, 1995; paras. (a)(2) and (a)(3) amended, 62 Fed. Reg. 40450, July 29, 1997, effective Oct. 1, 1997]

<sup>4</sup> The regulations at 37 C.F.R. §1.63 provide:

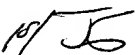
#### §1.63 Oath or declaration.

- (a) An oath or declaration filed under § 1.51(b)(2) as a part of an application must:
  - (1) Be executed in accordance with either § 1.66 or § 1.68;
  - (2) Identify the specification to which it is directed;
  - (3) Identify each inventor by: full name, including the family name, and at least one given name without abbreviation together with any other given name or initial, and the residence, post office address and country of citizenship of each inventor; and
  - (4) State whether the inventor is a sole or joint inventor of the invention claimed.
- (b) In addition to meeting the requirements of paragraph (a), the oath or declaration must state that the person making the oath or declaration:
  - (1) Has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration;
  - (2) Believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought; and
  - (3) Acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in §1.56.
- (c) In addition to meeting the requirements of paragraphs (a) and (b) of this section, the oath or declaration in any application in which a claim for foreign priority is made pursuant to § 1.55 must identify the foreign application for patent or inventor's certificate on which priority is claimed and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing.
- (d) --
  - (1) A newly executed oath or declaration is not required under § 1.51(b)(2) and § 1.53(f) in a continuation or divisional application, provided that:
    - (i) The prior nonprovisional application contained an oath or declaration as prescribed by paragraphs (a) through (c) of this section;
    - (ii) The continuation or divisional application was filed by all or by fewer than all of the inventors named in the prior application;
    - (iii) The specification and drawings filed in the continuation or divisional application contain no matter that would have been new

Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733.

Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or toll-free: (800) 972-6382 (outside the Washington D.C. area).

Telephone inquiries regarding this communication should be directed to the Petitions Attorney John J. Gillon, Jr., at (703)305-9199.



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matter in the prior application; and

(iv) A copy of the executed oath or declaration filed in the prior application, showing the signature or an indication thereon that it was signed, is submitted for the continuation or divisional application.

(2) The copy of the executed oath or declaration submitted under this paragraph for a continuation or divisional application must be accompanied by a statement requesting the deletion of the name or names of the person or persons who are not inventors in the continuation or divisional application.

(3) Where the executed oath or declaration of which a copy is submitted for a continuation or divisional application was originally filed in a prior application accorded status under § 1.47, the copy of the executed oath or declaration for such prior application must be accompanied by:

(i) A copy of the decision granting a petition to accord § 1.47 status to the prior application, unless all inventors or legal representatives have filed an oath or declaration to join in an application accorded status under § 1.47 of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c); and

(ii) If one or more inventor(s) or legal representative(s) who refused to join in the prior application or could not be found or reached has subsequently joined in the prior application or another application of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c), a copy of the subsequently executed oath(s) or declaration(s) filed by the inventor or legal representative to join in the application.

(4) Where the power of attorney (or authorization of agent) or correspondence address was changed during the prosecution of the prior application, the change in power of attorney (or authorization of agent) or correspondence address must be identified in the continuation or divisional application. Otherwise, the Office may not recognize in the continuation or divisional application the change of power of attorney (or authorization of agent) or correspondence address during the prosecution of the prior application.

(5) A newly executed oath or declaration must be filed in a continuation or divisional application naming an inventor not named in the prior application.

(e) A newly executed oath or declaration must be filed in any continuation-in-part application, which application may name all, more, or fewer than all of the inventors named in the prior application. The oath or declaration in any continuation-in-part application must also state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application. . . .

[48 Fed. Reg. 2711, Jan. 20, 1983, added effective Feb. 27, 1983; 48 Fed. Reg. 4285, Jan. 31, 1983; paras. (b)(3) and (d), 57 Fed. Reg. 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (a) revised, 60 Fed. Reg. 20195, Apr. 25, 1995, effective June 8, 1995; paras. (a) & (d) revised, para. (e) added, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997]